

II. REMARKS

A. Introduction

In this Office Action claims 1-3, 6-8, 16, 21 and 23-50 are noted as pending and are rejected.

In summary of this Response, the specification has been amended to update the parent information, independent claims 1, 16, 27, 33, 45, and 48 are amended, and remarks are provided.

B. Rejection of Claims

It is noted that the previous anticipation rejection based on Minato (Japanese Reference No. 1-172894) has been withdrawn. However, claims 1-3, 6-7, 16, 21, 23-25, 27-31, and 33-34 are rejected as being made obvious by a combination of Minato and Balthazor, U.S. Patent No. 3,083,499, cited by the Applicant in an Information Disclosure Statement May 14, 2007, but applied against the claims for the first time in this Office Action.

Minato is relied upon for the basic recited components of the turning members, leaf spring, etc. In particular regard to the leaf spring (36), same is described in the Action as being "located on top of the chassis... [and having]... a projecting portion or shaft (37) formed at a middle portion thereof in order to attach the leaf spring within a cleft in the frame... The cleft is formed by the hollow or unfilled space between protuberances or loops on a flat portion of the frame. Action, page 2, numbered paragraph 2, emphasis supplied.

The Action admits that Minato does not disclose "the recess portion being formed in the flat portion of the chassis." Action, page 3, line 3. Nevertheless, the Examiner relies on Balthazor for teaching "that it is well known in the toy art to hold a spring member in place by means of a recess (46) formed within a flat portion of a chassis." The Examiner argues that it would have been obvious to "substitute [the Balthazor] method [for holding the spring] for the [Minato method] to achieve the predictable result of holding a spring member in place." Action, page 3, lines 7-8.

Claims 8, 26, 32 and 38 are rejected as being made obvious by this combination and previously-cited Perryman, Great Britain Reference No. 1095490, on the ground that Perryman teaches plastic or metal springs.

Claims 45-50 are rejected as being made obvious by the Minato/Balthazor combination and further in view of previously-cited Booher, U.S. Patent No. 4,893,832. Again, this reference is cited for teaching independent movement of the ends of the leaf spring.

C. Amendments of Claims

Independent claims 1, 16, 27, 33, 45 and 48 have been amended by changing “a flat portion” to --a flat upper portion--. This amendment corresponds these claims with the similar recitations of independent claims 39 and 42.

D. Response to Rejection of Claims

From the Action's admission, it is clear that Minato does not teach or disclose the formation of a recess in the flat portion of the chassis. As noted above, each claim now recites that the recess is formed in the flat upper portion of the chassis. Thus, the issue under Graham v. John Deere and the more recent KSR, is whether the remaining prior art in combination taught the present invention as recited by the pending claims. It is respectfully submitted that the answer is no.

Initially, It is not clear as to what specific structure the Examiner is contemplating for the suggested combination of the Minato and Balthazor “methods” to supposedly arrive at the present invention. Balthazor does disclose a spring with a projection 48 to be received by a recess 46 as shown in, e.g., Figs. 3-5. The spring is located under a vehicle body 12 to exert downward pressure on a one piece axle 16 therebelow. However, how this structure could be combined with Minato to arrive at the present invention is not understood from the Office Action.

On the one hand, it is possible the Examiner is suggesting that the Balthazor “recess” (46) would be formed downward into the upper portion of the chassis (29) of Minato and the Minato leaf spring (36), with a Balthazor-like projection (48) formed to extend downwardly therefrom, would be placed on top of the chassis (29) so that the recess (46) would receive the projection (48). Such a combination, however, would not appear to be operable as recited herein. That is, it is doubted such a leaf spring would exert biasing pressure on the turning members as the projection (48) would not be held by the recess (46), especially when, e.g., a wheel hits a bump and the turning member moves the leaf spring upward. In this regard, a prime object of Minato is to allow biased, vertical movement of the wheel turning members (see, e.g., translation, page 2, third full paragraph, and page 3, first full paragraph), an object that would be thwarted by Balthazor's structure preventing biased force on the wheel turning members. Thus, even if this is the suggested structure, the Examiner does not indicate how such a leaf spring would or could create the biasing force recited in each independent claim, especially under the influence of the upward movement of the wheel turning members.

On the other hand, perhaps the Examiner is suggesting that the recess (46) would be formed in the chassis (29) from below to extend upwardly, and the leaf spring 36 of Minato would have a projection (48) that extends upwardly to be received by the recess (46) when the leaf spring is placed below the chassis, the structure shown in Balthazor. However, this configuration is also inconsistent with the claims since the spring would not be above the upper chassis member.

In response to the arguments made in the June 12, 2008 Response, the Examiner indicates that “while Minato does show a configuration of the leaf spring received above the flat surface of the support member the reference does not specifically criticize, discredit or discourage alternate solutions.” However, there is no evidence provided by the Examiner as to why one of ordinary skill in this art at the time of the present invention would have considered modifying the Minato structure as the Examiner now suggests, and certainly no evidence of such “alternate solutions”, what they might structurally be or whether they would be operable.

There must be some reason, suggestion, or motivation found in the prior art whereby a person of ordinary skill in the field of the invention would consider the combination. That knowledge cannot come from the applicant's invention itself. The Examiner should concretely show the same, suggestion, or motivation found in the prior art.

In the present case, Minato only shows and describes loops that are attached to and extend upwardly from the upper chassis. Minato teaches that the see-saw member 36 is “arranged above the support member 29”. Translation, page 7, first full paragraph. It is further noted that ends of a shaft 37 formed on the leaf spring “are engaged with the loop-like receiving portions 38a, 38b provided in a protruding condition on the support member 29.” Id.

Thus, what is clear from Minato is that the see-saw member is to be positioned above the upper chassis in loops. Also, the see-saw member must provide some biasing to the wheel turning members. Alternate structures that satisfy this biasing are not disclosed by Minato, and the reference does not suggest alternate structures, nor criticize any alternate structures (except those that do not allow the wheel turning members to move vertically). Nevertheless, the mere lack of criticism does not necessarily support the conclusion that one of ordinary skill would conjure up the solution provided by the present invention, and expecting the operability required by Minato, e.g., biasing and assembly from above.

Finally, the Examiner's position in regard to the Minato/Balthazor teachings is again inconsistent with the Examiners that have handled the reexamination of the parent U.S. Patent No. 6,651,011. A copy of the Right of Appeal Notice in the Reexamination is attached for the convenience of the Examiner. In responding to the reexamination requester's obviousness

argument regarding certain claims under reexamination, including original claim 5 of the parent herein, U.S. Patent No. 6,656,011, based on a combination of Minato and Balthazor, the Examiner stated "Contrary to requester's contention, Balthazor does not show a recess in the upper surface of that chassis. Balthazor shows a recess in the lower portion of the chassis. In addition, there is no teaching of reversing the arrangement of Balthazor in order to arrive at leaf spring mount as recited ..." Right of Appeal Notice, page 29, numbered paragraphs 42-44." See, also page 31, last four lines, of the Right of Appeal Notice in the above-referenced reexamination, wherein it is stated: "The Examiner concurs with the Patent Owner's comments ... that Minato, Duchemin and Balthazor fail to show the connection of the leaf spring at the upper surface of the upper chassis."

In light of the above, while Minato does show a leaf spring mounted above an upper chassis member via upwardly extending open loops, the reference fails to show reception of at least a portion of the leaf spring within a recess formed in the upper chassis member. The prior art, and certainly Balthazor, fails to teach this recess being formed in the upper chassis, along with the remaining recited features, such as the biasing.

Neither of the secondary references, i.e., Perryman or Booher, is cited for disclosing or teaching the formation of a recess in a flat upper portion of the chassis and neither in fact includes such disclosure or teaching. Thus, neither of these references could compensate for the incomplete teaching of Minato.

Accordingly, it is respectfully submitted that claims 1-3, 6-8, 16, 21 and 23-50 are patentable over this prior art, either alone or in combination with Minato.

III. CONCLUSION

In light of the above amendments and remarks, it is respectfully submitted that claims 1-3, 6-8, 16, 21 and 23-50 are now in condition for allowance.

If there are any additional fees associated with this Response, please charge same to our Deposit Account No. 19-3935.

Finally, if there are any formal matters remaining after this Response, the undersigned would appreciate a telephone conference with the Examiner to attend to these matters.

Respectfully submitted,

STAAS & HALSEY LLP

Date: _____

1/21/09

By: _____


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WTH



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CONTROL NO.	FILING DATE	PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
95/000,036	02/20/04	6,656,011	1419.1061 REX

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EXAMINER

GRAHAM, M.

ART UNIT

PAPER

3993

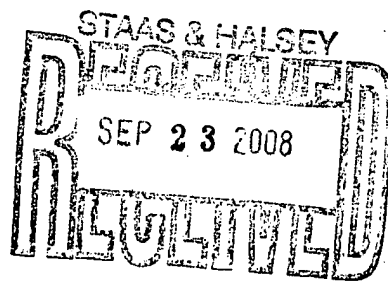
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**INTER PARTES REEXAMINATION
COMMUNICATION**

BELOW/ATTACHED YOU WILL FIND A COMMUNICATION FROM THE UNITED STATES PATENT AND TRADEMARK OFFICE OFFICIAL(S) IN CHARGE OF THE PRESENT REEXAMINATION PROCEEDING.

All correspondence relating to this *inter partes* reexamination proceeding should be directed to the **Central Reexamination Unit** at the mail, FAX, or hand-carry addresses given at the end of this communication.





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**Transmittal of Communication to Third Party Requester
Inter Partes Reexamination**

REEXAMINATION CONTROL NUMBER 95/000,036.

PATENT NUMBER 6,656,011.

TECHNOLOGY CENTER 3999.

ART UNIT 3993.

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above-identified reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the *inter partes* reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an *ex parte* reexamination has been merged with the *inter partes* reexamination, no responsive submission by any *ex parte* third party requester is permitted.

All correspondence relating to this *inter partes* reexamination proceeding should be directed to the **Central Reexamination Unit** at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.

**Right of Appeal Notice
(37 CFR 1.953)**

Control No.

95/000,036

Examiner

MATTHEW C. GRAHAM

Patent Under Reexamination

6656011

Art Unit

3993

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address. --

Responsive to the communication(s) filed by:

Patent Owner on 24 October 2007

Third Party(ies) on 19 November 2007

Patent owner and/or third party requester(s) may file a notice of appeal with respect to any adverse decision with payment of the fee set forth in 37 CFR 41.20(b)(1) within **one-month or thirty-days (whichever is longer)**. See MPEP 2671. In addition, a party may file a notice of **cross** appeal and pay the 37 CFR 41.20(b)(1) fee **within fourteen days of service** of an opposing party's timely filed notice of appeal. See MPEP 2672.

All correspondence relating to this inter partes reexamination proceeding should be directed to the **Central Reexamination Unit** at the mail, FAX, or hand-carry addresses given at the end of this Office action.

If no party timely files a notice of appeal, prosecution on the merits of this reexamination proceeding will be concluded, and the Director of the USPTO will proceed to issue and publish a certificate under 37 CFR 1.997 in accordance with this Office action.

The proposed amendment filed 10/24/2007 ☒ will be entered ☐ will not be entered*

*Reasons for non-entry are given in the body of this notice.

- 1a. ☒ Claims 1-50 are subject to reexamination.
- 1b. ☐ Claims _____ are not subject to reexamination.
2. ☒ Claims 1-4,7-12,22-25 and 28-41 have been cancelled.
3. ☒ Claims 5 and 6 are confirmed. [Unamended patent claims].
4. ☒ Claims 13-19,26,27 and 42-50 are patentable. [Amended or new claims].
5. ☒ Claims 20 and 21 are rejected.
6. ☐ Claims _____ are objected to.
7. ☐ The drawings filed on _____ ☐ are acceptable. ☐ are not acceptable.
8. ☐ The drawing correction request filed on _____ is ☐ approved. ☐ disapproved.
9. ☐ Acknowledgment is made of the claim for priority under 35 U.S.C. 119 (a)-(d) or (f). The certified copy has:
☐ been received. ☐ not been received. ☐ been filed in Application/Control No. _____.
10. ☐ Other _____

Attachments

1. ☐ Notice of References Cited by Examiner, PTO-892
2. ☐ Information Disclosure Citation, PTO/SB/08
3. ☐ _____

RIGHT OF APPEAL NOTICE

1. Receipt is acknowledged of Patent Owner's Amendment, which has been entered, and Comments filed on 10/24/2007.
2. Receipt is acknowledged of the Third Party Requester's Comments filed on 11/19/2007.

Rejections Proposed by Third Party Requester in Request for Reexamination

The following grounds of rejection were proposed by the third party requester in the request for reexamination (see pages 9-10, as well as Exhibits I and J of the request):

3. **Ground #1**. The third party requester proposes that claims 1, 2, 4, 5, 11 and 12 be rejected under 35 U.S.C. 102(b) as being anticipated by Minato.

This proposed rejection is not adopted for the following reasons:

The proposed rejection of claims 1, 2, 4, 11 and 12 is not adopted due to the cancellation of those claims.

The proposed rejection of claim 5 was not adopted by the examiner in the first Office action and in the Previous Previous Action Closing Prosecution, and the examiner's position remains unchanged.

While Minato does disclose a see-saw member 36, which is supported on the upper chassis 29 through elements 38a and 38b, Minato fails to teach a "recess portion formed in the upper surface of the upper chassis". The Merriam Webster's

Art Unit: 3993

Collegiate Dictionary, Tenth Edition defines a "recess" as an "indentation or cleft", therefore one with ordinary skill in the art would not interpret the loop-like members (38a and 38b) of Minato as a recess since they are not indentations or clefts.

Additionally the loop-like members of Minato are not in the upper surface of the upper chassis, as required by claim 5, but rather on the upper surface, thus Minato lacks the structural features as recited in claim 5 and therefore does not anticipate the claim.

Since the mailing of the last Office action, neither party has provided arguments or comments on the proposed rejection of claim 5.

4. **Ground #2.** The third party requester proposes that claims 3, 6 and 7 be rejected under 35 U.S.C. 103(a) as being unpatentable over Minato.

This proposed rejection is **not adopted** for the following reasons:

The proposed rejection of claims 3 and 7 is **not adopted** due to the cancellation of those claims.

The proposed rejection of claim 6 was **not adopted** by the examiner in the first Office action and in the Previous Previous Action Closing Prosecution, and the examiner's position remains unchanged.

In the request, at page 9 of the request and page 4 of exhibit G, the third party requester proposes that claim 6 be rejected over Minato. The third party requester points out that Minato teaches an upper chassis (29) a see-saw (or leaf spring) member 36 which is supported on the upper chassis 29 through elements 38a and 38b and shaft

Art Unit: 3993

37 and that it would have been obvious to support the leaf spring on the upper chassis in different manners.

Despite the argument presented at page 4 of exhibit G, there does not appear to be any motivation or teaching that would allow one of ordinary skill in the art to modify the Minato reference to a structure in which the leaf spring is sandwiched between the shaft and the recess as recited in claim 6.

Since the mailing of the last Office action, neither party has provided arguments or comments on the proposed rejection of claim 6.

5. **Ground #3.** The third party requester proposes that claims 1-7 and 11-12 be rejected under 35 U.S.C. 103(a) as being obvious over Minato in view of Sakai.

This proposed rejection is **not adopted** for the following reasons:

The proposed rejection of claims 1-4, 7 and 11-12 is **not adopted** due to the cancellation of those claims.

The proposed rejection of claims 5 and 6 was **not adopted** by the examiner in the first Office action and in the Previous Action Closing Prosecution, and the examiner's position remains unchanged.

In the request, at page 9 of the request and exhibit H (page 5), the third party requester proposes that claims 5 and 6 are rejected over Minato in view of Sakai.

Regarding claim 5, the third party requester points out that Sakai discloses a mounting hole 8 at which the leaf spring 5 is held onto the frame 2. With respect to

Art Unit: 3993

claim 6, the third party requester states that it would have been obvious to support the leaf spring on the upper chassis in different manners.

While Sakai does teach a mounting hole 8 at which the leaf spring 5 is held in relation to the frame, the modification of the Minato reference taken with Sakai would not have been obvious to one having ordinary skill in the art and would destroy the functionality of Minato. In order to make the combination work as argued, one would have to essentially replace the spring leaf of Minato with the spring leaf of Sakai. Furthermore, the upper chassis of Minato would have to be modified to remove the loop-like portions and provided with a mounting hole in their place. The resulting structure would then resemble the Sakai spring structure and would have to be mounted underneath the upper chassis of Minato at which point it would no longer resemble or function as a "see-saw" structure of Minato, thus destroying Minato's invention. Furthermore, the leaf spring would no longer be held on an upper surface of the upper chassis as required by claim 5. Therefore, it would not have been obvious to combine the hole structure of Sakai with the structure of Minato despite the arguments presented on page 5 of exhibit H. Regarding the case of obviousness with respect to claim 6, despite the argument presented at page 5 of exhibit H, there does not appear to be any motivation or teaching in Sakai that would allow/motivate one of ordinary skill in the art to modify the Minato reference to achieve the sandwiching of the leaf spring as recited in claim 6.

Since the mailing of the last Office action, neither party has provided arguments or comments on the proposed rejection of claims 5 and 6.

6. **Ground #4.** The third party requester proposes that claims 1-2 and 11-12 be rejected under 35 U.S.C. 102(b) as being anticipated by Kumazawa.

This proposed rejection is **not adopted** due to cancellation of claims 1-2 and 11-12. This proposed rejection was **not adopted** by the examiner in the first Office action and in the Previous Action Closing Prosecution.

7. **Ground # 5.** The third party requester proposes that claims 3 and 7 be rejected under 35 U.S.C. 103(a) as being obvious over Kumazawa.

Ground #5, appearing on page 9 of the request, lists claims 3 and 6. Exhibit I, however, lists claim 7 as being unpatentable over Kumazawa alone, but claim 7 is omitted from Ground #5 in the request. Furthermore, claim 6 depends from claim 5, which is listed under Ground #6 in the request for reexamination as being obvious over Minato in view of Kumazawa. Therefore, Ground #5, as it appears above, was modified in the first Office action to conform to the existing claim dependency and to Exhibit I.)

This proposed rejection is **not adopted** for the following reasons:

The proposed rejection of claims 3 and 7 are **not adopted** due to the cancellation of those claims. The proposed rejection of claims 3 and 7 was **not adopted** by the examiner in the first Office action and in the Previous Action Closing Prosecution.

Art Unit: 3993

8. **Ground #6.** The third party requester proposes that claims 4, 5, and 6 be rejected under 35 U.S.C. 103(a) as being obvious over Minato in view of Kumazawa.

This proposed rejection is **not adopted** for the following reasons:

The proposed rejection of claim 4 is **not adopted** due to the cancellation of claim 4.

The proposed rejection of claims 5 and 6 was **not adopted** by the examiner in the first Office action and in the Previous Action Closing Prosecution, and the examiner's position remains unchanged.

In the request, at page 9 of the request and exhibit I (pages 4-5), the third party requester proposes that claims 5 and 6 be rejected over Minato in view of Kumazawa. The third party requester states that it would have been obvious to combine the teaching of Minato and Kumazawa to arrive at the "recess portion formed in the upper surface of the upper chassis at a middle portion thereof, in which the curved middle portion of the leaf spring is held on the upper chassis" as recited in claim 5. The third party requestor also contends that it would have been further obvious to support the leaf spring on the upper chassis in different manners in order to show the leaf spring being "sandwiched between the recess portion of the upper chassis and a shaft located on the upper chassis" as recited in claim 6.

Neither Minato nor Kumazawa show a recess portion formed in the upper surface of the upper chassis as recited in claim 5. Neither Minato nor Kumazawa provide any teaching or motivation to modify the toy of Minato to include a recess portion as recited in claim 5. Re-claims 6, neither Minato nor Kumazawa show any type of sandwich

Art Unit: 3993

construction for the spring and shaft as recited in claim 6. Thus it would not have been obvious to modify the suspension of Minato to meet the required structure as recited in claims 5 and 6.

Since the mailing of the last Office action, neither party has provided arguments or comments on the proposed rejection of claims 5 and 6.

9. **Ground #7.** The third party requester proposes that claims 8 and 9 be rejected under 35 U.S.C. 102(b) over Perryman.

This proposed rejection is **not adopted** due to cancellation of claims 8 and 9.

10. **Ground #8.** The third party requester proposes that claim 10 be rejected under 35 U.S.C. 103(a) as being obvious over Perryman.

This proposed rejection is **not adopted** due to cancellation of claim 10.

11. **Ground #9.** The third party requester proposes that claims 8 and 9 be rejected under 35 U.S.C. 102(b) as being anticipated by Allen.

Ground #9, appearing on page 9 of the request, also lists an alternative proposed rejection of claims 8 and 9 under 35 U.S.C. 103(a). This alternative proposed rejection has been addressed under Ground #11.

The proposed rejection of claims 8 and 9 under 35 U.S.C. 102(b) over Allen is **not adopted** due to the cancellation of those claims.

This proposed rejections was **not adopted** by the examiner in the first Office action and in the Previous Action Closing Prosecution.

Art Unit: 3993

12. **Ground #10.** The third party requester proposes that claim 10 be rejected under 35 U.S.C. 103(a) as being obvious over Allen.

The proposed rejection of claim 10 under 35 U.S.C. 103(a) over is **not adopted** due to the cancellation of this claim.

This proposed rejection was **not adopted** by the examiner in the first Office action and in the Previous Action Closing Prosecution.

13. **Ground #11.** The third party requester proposes that claims 8 and 9 be rejected under 35 U.S.C. 103(a) as being obvious over Allen.

The proposed rejection of claims 8 and 9 under 35 U.S.C. 103(a) over Allen is **not adopted** due to the cancellation of these claims.

This proposed rejection was **not adopted** by the examiner in the first Office action and in the Previous Action Closing Prosecution.

14. **Ground #12.** The third party requester proposes that claims 8 and 9 be rejected under 35 U.S.C. 103(a) as being obvious over Allen in view of Perryman. This rejection was proposed by the third party requester in Exhibit J of the request for reexamination.

This proposed rejection is **not adopted** due to the cancellation of claims 8 and 9.

Rejections Proposed by the Third Party Requester in Comments Filed

August 6, 2004

15. **Ground #13.** The third party requester proposes that claims 13-19 be rejected under 35 U.S.C. 112, first paragraph.

This proposed rejected was **not adopted** by the examiner in the Previous Action Closing Prosecution, and the examiner's position remains unchanged.

The requester proposes that the limitation encompassed by "the respective ends of the leaf spring can move individually to bias each turning member separately" introduces new subject matter, is not supported by the written description and lacks enablement. It is further proposed that claim 13 should be rejected for failing to claim critical features. Specifically, it is argued that Fig. 12A and corresponding text at col. 7, lines 28-40 do not provide adequate support for the above limitations and therefore the newly added limitation contains new matter and thusly, is not enabled by the written description. It is further argued that it is critical to include the shaft limitation in the claims since the '011 patent fails to indicate that the shaft is optional or provide for any other alternatives of how the leaf member is held in place.

Fig. 12A and corresponding text at col. 7, lines 28-40 clearly describe a suspension that imparts a biasing force to a single wheel or both wheels depending whether a single front wheel is moved up (figure 12A) or if both front wheels are moved up (figure 12B), therefore the individual movement is supported by the written

Art Unit: 3993

description and not construed to be new matter. Regarding the question of enablement, a person with ordinary skill in the art would be able to construct the invention of patent '011 by following its respective figures and portions of the disclosure. Additionally, it should be noted that one having ordinary skill in the art would understand that the function of ends moving individually to bias each turning member separately may be achieved in a variety of ways including a selection of a material of appropriate characteristics such that upward movement of one end would not create any substantial downward biasing force in the other end. With respect to the concept of critical features, it is pointed out that a patent applicant may claim as much or as little of his/her invention as they desire (depending on the desired level of protection) so long as the claims meet the requirements of 35 U.S.C. 112, 1st and 2nd paragraphs. In this case the question becomes whether the claims meet the requirement of 35 U.S.C. 1st paragraph. It has been held that if the specification discloses that a particular feature or element is critical or essential to the practice of the invention, failure to recite or include that particular feature or element in the claims may provide a basis for a rejection based on the ground that those claims are not supported by an enabling disclosure. In re Mayhew, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976). In Mayhew, the examiner argued that the only mode of operation of the process disclosed in the specification involved the use of a cooling zone at a particular location in the processing cycle. The claims were rejected because they failed to specify either a cooling step or the location of the step in the process. The court was convinced that the cooling bath and its location were essential, and held that claims which failed to recite

Art Unit: 3993

the use of a cooling zone, specifically located, were not supported by an enabling disclosure (35 U.S.C. 112, first paragraph). In this case, the claims do not omit any steps or structure which would not allow the device to function as intended since patent '011 never explicitly states that the use of the shaft 41 is the only means (or critical) of holding the leaf spring in position and since one having ordinary skill in the art would understand that the leaf spring member may be held in place by a variety of means (note: patent '011 clearly states at col. 8, lines 30-34 that various changes made be made: without departing from the gist of the invention). Therefore claims 13-19 are not rejected under 35 U.S.C. 112, 1st paragraph.

16. **Ground #14**. The third party requester proposes that claims 13-19 be rejected under 35 U.S.C. 102(b) as being anticipated by Minato.

This proposed rejected was **not adopted** by the examiner in the Previous Action Closing Prosecution, and the examiner's position remains unchanged.

In the requester's comments filed on August 06, 2004, at page 30 of the remarks section, the third party requester proposes that claims 13-19 be rejected based upon Minato. Specifically, the third party requester states that since the leaf spring of Minato can have elastic properties and its vertical movement is limited it must then be able to move independently and bias the turning members separately.

Although Minato discloses most of the features of claim 13 (see paragraphs 3-4, **Grounds #1-2**) including that member 36 may be elastic, Minato further discloses that member 36 acts as a seesaw (figure 2 and 4b). With such construction when pressure

Art Unit: 3993

is applied to one of the front wheels in an upward direction (i.e. a bump on the running surface) the wheel assembly is moved up resulting in seesaw movement of member 36 and a biasing force on both of the wheels (see figure 4b). If both wheels come into contact with a bump in the road member 36 would once again create a biasing force on both of the wheels. Thus since member 36 is structured to provide a seesaw motion it would not be possible for one of its ends to move individually to bias each turning member separately. Therefore claims 13-19 are not anticipated by Minato '894.

17. **Ground #15.** The third party requester proposes that claims 20-21 be rejected under 35 U.S.C. 112, first paragraph.

This proposed rejection was **not adopted** by the examiner in the Previous Action Closing Prosecution, and the examiner's position remains unchanged.

In the requester's comments filed on August 06, 2004, at page 31 of the remarks section, the third party requester proposes that claims 20-21 be rejected for failing to meet the requirements of 35 U.S.C. 112, 1st paragraph. The requester proposes that the limitation encompassed by "the respective ends of the leaf spring can move individually to bias each turning member separately" introduces new subject matter, is not supported by the written description and lacks enablement. It is further proposed that the claims should be rejected for failing to claim critical features. The third party requester uses the same reasoning for the rejection as stated above in paragraph 15 with respect to claims 13-19.

Art Unit: 3993

Fig. 12A and corresponding text at col. 7, lines 28-40 clearly describe a suspension that imparts a biasing force to a single wheel or both wheels depending whether a single front wheel is moved up (figure 12A) or if both front wheels are moved up (figure 12B), therefore the above limitation is supported by the written description and not construed to be new matter. Regarding the question of enablement, a person with ordinary skill in the art would be able to construct the invention of patent '011 by following its respective figures and portions of the disclosure. Additionally, it should be noted that one having ordinary skill in the art would understand that the function of ends moving individually to bias each turning member separately may be achieved in a variety of ways including a selection of a material of appropriate characteristics such that upward movement of one end would not create any substantial downward biasing force in the other end. With respect to the concept of critical features, it is pointed out that a patent applicant may claim as much or as little of his/her invention as they desire (depending on the desired level of protection) so long as the claims meet the requirements of 35 U.S.C. 112, 1st and 2nd paragraphs. See the previous discussion of *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976) in paragraph 15 above.

In this case, the claims do not omit any steps or structure which would not allow the device to function as intended since patent '011 never explicitly states that the use of the shaft 41 is the only means (or critical) of holding the leaf spring in position and since one having ordinary skill in the art would understand that the leaf spring member may be held in place by a variety of means (note: patent '011 clearly states at col. 8, lines 30-34 that various changes made be made without departing from the gist of the

Art Unit: 3993

invention). Therefore claims 20-21 are not rejected under 35 U.S.C. 112, 1st paragraph.

18. **Ground #16.** The third party requester proposes that claims 20-21 be rejected under 35 U.S.C. 102(b) as being anticipated by Minato.

This proposed rejected was **not adopted** by the examiner in the Previous Action Closing Prosecution, and the examiner's position remains unchanged.

In the requester's comments filed on August 06, 2004, at page 30 of the remarks section, the third party requester proposes that claims 20-21 be rejected based upon Minato. Specifically, the third party requester states that since the leaf spring of Minato can have elastic properties and its vertical movement is limited it must then be able to move independently and bias the turning members separately.

Although Minato discloses most of the features of claim 20 (see paragraphs 3-4) including the member 36 being elastic, Minato further discloses that member 36 acts as a seesaw (figure 2 and 4b). With such construction, when pressure is applied to one of the front wheels in an upward direction (i.e. a bump on the running surface) the wheel assembly is moved up resulting in seesaw movement of member 36 and a biasing force on both of the wheels (see figure 4b). If both wheels come into contact with a bump in the road member 36 would once again create a biasing force on both of the wheels. Thus since member 36 is structured to provide a seesaw motion it would not be possible for one of its ends to move individually to bias each turning member separately. Therefore claims 20-21 are not anticipated by Minato.

19. **Ground #17.** The third party requester proposes that claims 22-28 be rejected under 35 U.S.C. 112, first paragraph.

The proposed rejection of claims 22-25 and 28 is **not adopted** due to the cancellation of those claims. The proposed rejection of claims 26 and 27 (and, for that matter, claims 22-25 and 28) were **not adopted** by the examiner in the Previous Action Closing Prosecution, and the examiner's position remains unchanged.

In the requester's comments filed on August 06, 2004, at page 31 of the remarks section, the third party requester proposes that claims 22-28 be rejected for failing to meet the requirements of 35 U.S.C. 112, 1st paragraph, specifically failure to claim all critical features. Specifically, it is argued that it is critical to include the shaft limitation in the claims since the '011 patent fails to indicate that the shaft is optional or provide for any other alternatives of how the leaf member is held in place.

It has been held that if the specification discloses that a particular feature or element is critical or essential to the practice of the invention, failure to recite or include that particular feature or element in the claims may provide a basis for a rejection based on the ground that those claims are not supported by an enabling disclosure. Note the previous discussion of *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976) in paragraph 15 above.

In this case, the claims do not omit any steps or structure, which would not allow the device to function as intended since patent '011 never explicitly states that the use of the shaft 41 is the only means (or critical) of holding the leaf spring in position

Art Unit: 3993

and since one having ordinary skill in the art would understand that the leaf spring member may be held in place by a variety of means (note: patent '011 clearly states at col. 8, lines 30-34 that various changes made be made without departing from the gist of the invention). Therefore claims 26-27 are not rejected under 35 U.S.C. 112, 1st paragraph.

20. **Ground #18.** The third party requester proposes that claims 22-23, 25, and 29-30 be rejected under 35 U.S.C. 102(b) as being anticipated by Minato.

This proposed rejection is **not adopted** due to the cancellation of claims 22-23, 25 and 29-30.

21. **Ground #19.** The third party requester proposes that claims 24 and 28 be rejected under 35 U.S.C. 103(a) as being obvious over Minato.

This proposed rejection is **not adopted** due to the cancellation of claims 24 and 28.

22. **Ground #20.** The third party requester proposes that claims 29-30 be rejected under 35 U.S.C. 112, first paragraph.

This proposed rejection is **not adopted** due to the cancellation of claims 29-30. Furthermore, this proposed rejection was **not adopted** in the Previous Action Closing Prosecution.

Art Unit: 3993

23. **Ground #21.** The third party requester proposes that claims 31-37 be rejected under 35 U.S.C. 112, first paragraph.

This proposed rejection is **not adopted** due to the cancellation of claims 31-37.

24. **Ground #22.** The third party requester proposes that claims 31-32, 34 and 38-39 be rejected under 35 U.S.C. 102(b) as being anticipated by Minato.

This proposed rejection is **not adopted** due to the cancellation of claims 31-32, 34, and 38-39.

25. **Ground #23.** The third party requester proposes that claims 36 and 37 be rejected under 35 U.S.C. 103(a) as being obvious over Minato.

The third party requester also proposes that claim 40 be rejected under 35 U.S.C. 314(a) as enlarging the scope of the claims of the patent being reexamined.

These proposed rejections are **not adopted** due to the cancellation of claims 36, 37, and 40.

26. **Ground #24.** The third party requester proposes that claims 40 and 41 be rejected under 35 U.S.C. 112, first paragraph.

This proposed rejection is **not adopted** due to the cancellation of claims 40 and 41.

Furthermore, this proposed rejection was **not adopted** in the Previous Action Closing Prosecution.

27. **Ground #25.** The third party requester proposes that claims 40 and 41 be rejected under 35 U.S.C. 102(b) as being anticipated by Minato.

This proposed rejection is **not adopted** due to the cancellation of claims 40 and 41.

28. **Ground #26.** The third party requester proposes that claims 42 and 43 be rejected under 35 U.S.C. 102(b) as being anticipated by Minato.

This proposed rejection was **not adopted** by the examiner in the Previous Action Closing Prosecution, and the examiner's position remains unchanged.

It is proposed at pages 39-40 of the requestor's comments filed on August 6, 2004 that Minato discloses all of the elements of claims 42 and 43.

Claim 42 is a restatement of a combination of claims 1 and 5, while claim 43 is a restatement of claim 6. The proposed rejection(s) of a combination of claim 42 (i.e. combination of claim 1 and 5) is not anticipated by Minato due to the limitation of "...wherein the upper chassis comprises a recess portion formed in the upper surface of the upper chassis at a middle portion thereof..."

Minato does not show or suggest any such recess in an upper surface of the upper chassis.

29. **Ground #27.** The third party requester proposes that claims 5, 6, 42, and 43 be rejected under 35 U.S.C. 103(a) as being obvious over Minato.

This proposed rejection was not adopted by the examiner in the Previous Action Closing Prosecution, and the examiner's position remains unchanged.

It is proposed at pages 6 and 11 and 39-40 of the requestors comments filed on August 6, 2004 that claims 5-6, 42 and 43 are obvious over Minato as supported by the Declaration filed on August 6, 2004.

The requestor points out that the modification to Minato to incorporate the structure of claim 5, and conversely claim 42, is suggested by Minato, suggested by the knowledge of one of ordinary skill in the art and derived from the nature of the problem to be solved. It is further pointed out by the requestor, at page 9 of the comments section filed on August 6, 2004 that Minato teaches other components held in recesses, that components held in recess are within ordinary knowledge in the art as evidenced by the examples cited in the Declaration of Mr. Rotheiser and Exhibit E and the structure of patent '011 is an obvious solution to the problem of retention of the fulcrum portion of the leaf spring relative the chassis in order to make it detachable.

It is agreed that supporting an item in a recess is known in the art, however in this case it is not a question of whether it is known to secure one element to another through the use of a recess but rather if it would have been obvious to modify the structural features of Minato to provide for a structure like of a combination of claims 1 and 5, or claim 42 of patent '011 without destroying the functionality of Minato. In this case such a modification would not have been obvious. There is nothing in the prior art of record which would lead one having ordinary skill in the art to the modification as proposed. In fact such a modification would render the chassis system of Minato inoperable as

Art Unit: 3993

intended. For example, providing a recess in the upper surface of the support member 29 of Minato would also require that the leaf spring 36 be provided with an appropriate curvature (like that of patent '011) such that it continues to function as intended (see-saw motion) while at the same time providing a member which would limit the upward movement of the leaf spring due to forces of members 24b and 23b acting upon it. Essentially, one of ordinary skill in the art would have to reconfigure the Minato patent to have the structural features of patent '011, however there is no prior art of record that would motivate an artisan to modify the Minato reference to produce such a chassis construction. In other words, the open recess construction as shown in patent '011 and called obvious by Mr. Rotheiser would not function with the leaf spring of Minato as there would be no shaft 41 to hold the leaf spring in place and the leaf spring of Minato does not have the curved portion as would be required in order to function as envisioned. Furthermore it should be noted that although, as stated by Mr. Rotheiser, 1st class levers have been known for thousands of years, in this case the question is whether it would have been obvious to modify the construction of Minato in order to incorporate such a lever device, in which case once again there is not any motivation to do so.

Claim 42 is a restatement of a combination of claims 1 and 5, while claim 43 is a restatement of claim 6. The proposed rejection(s) of claims 5-6, 42 and 43 is not made obvious over Minato due there being no teaching or suggestion of a structure "...wherein the upper chassis comprises a recess portion formed in the upper surface of the upper chassis at a middle portion thereof."

This rejection of claims 5-6, 42 and 43 as proposed by the third party requester is not adopted.

30. **Ground #28.** The third party requester proposes that claims 5, 6, 42, and 43 be rejected under 35 U.S.C. 112, first paragraph.

This proposed rejection was **not adopted** by the examiner in the Previous Action Closing Prosecution, and the examiner's position remains unchanged.

In the requester's comments filed on August 06, 2004, at pages 11 (with respect to claims 5-6) and page 40 (with respect to claims 42 and 43) of the remarks section, the third party requester proposes that claims 5 and 42 be rejected for failing to meet the requirements of 35 U.S.C. 112, 1st paragraph, specifically failure to claim all critical features/enablement. Specifically, it is argued that it is critical to include the shaft limitation in the claims since the '011 patent fails to indicate that the shaft is optional or provide for any other alternatives of how the leaf member is held in place.

This rejection of claims 5-6, 42 and 43 as proposed by the third party requester is not adopted.

Reasoning for not adopting the proposed rejection is the same as and detailed in paragraph 19, **Ground #17**, with respect to claims 22-28.

Since the mailing of the last Office action, neither party has provided arguments or comments on this proposed rejection.

Rejections Proposed by the Third Party Request in Comments Filed

August 17, 2005

31. **Ground #29.** The third party requester proposes that claims 5 and 6 be rejected under 35 U.S.C. 112, second paragraph.

This proposed rejection is **not adopted.**

The third party requester proposes that claims 5 and 6 depend from a cancelled claim, and should therefore be rejected as incomplete.

In reexamination proceedings, however, a claim may depend from a canceled claim. See MPEP 2660.03, which states, in pertinent part (emphasis in original): "If an unamended base patent claim (i.e., a claim appearing in the patent) has been rejected or canceled, any claim which is directly or indirectly dependent thereon should be indicated as patentable if it is otherwise patentable. The dependent claim should not be objected to nor rejected merely because it depends upon a rejected or canceled original patent claim. *No requirement should be made for rewriting the dependent claim in independent form.* As the original patent claim numbers are not changed in a reexamination proceeding, the content of the canceled base claim would remain in the printed patent and would be available to be read as a part of the dependent claim."

32. **Ground #30.** The third party requester proposes that claim 26 be rejected under 35 U.S.C., first paragraph.

This proposed rejection is **not adopted.**

The third party requester proposes that claim 26 fails to satisfy the enablement requirement because claim 26 fails to recite the shaft shown in Figure 11.

The lack of a recitation of the shaft, however, does not make the claim indefinite. There is no requirement that every feature and/or structure of an invention be claimed. Please note the previous discussion of *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976) in paragraph 15 above.

Status of Rejections Proposed by the Examiner on 1/30/2007

33. **Ground #31** .The specification is NOT objected to as failing to provide proper antecedent basis for the claimed subject matter due to the amendments to claim 26 and the amendment to the specification filed on 3/30/2007.

34. **Ground #32**. Claims 26-27 are NOT rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement due to the amendment to claim 26 on 3/30/2007, which deletes the word pivot.

35. **Ground #33**. Claims 26-27 are NOT rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention due to the amendment to claim 26 on 3/30/2007.

Art Unit: 3993

36. **Ground #34.** The third party requester proposes that claims 13, 14, 15, 16, and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Minato in view of U.S. Patent 3,749,389 to Duchemin.

This rejection was originally proposed in the non-final action on 1/30/2007 and is no longer adopted.

As amended on 10/24/2007, neither Minato nor Duchemin show the middle portion of the leaf spring in a width direction being supported on an **upper surface** of the upper chassis as now recited in claim 13. The third party comments filed on 11/19/07 regarding this proposed rejection will be addressed at the end of this Office action in paragraph 49.

Ground #34A. Claims 20-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Minato in view of US Patent 3,749,389 to Duchemin.

Minato discloses a steering device for a radio-controlled toy automobile. Minato teaches a right and left bracket 23 and 24 for turning right and left wheels 27 and 28 about a vertical axis. The left and right brackets 23 and 24 include corresponding pins 23a, 23b and 24a, 24b, respectively, which cooperate with a chassis of the toy automobile to support the left and right brackets 23 and 24 as described in page 6 of the Minato translation. In particular, the pin 23a of the left bracket 23 fits into a pin hole 22 formed through a lower portion of the chassis, and the pin 23b fits into a pin hole 29a formed through a support member 29 disposed above the bracket 23 as described in pages 6-7 of the Minato translation. Similarly, the pin 24a of the right bracket 24 fits into a pin hole 21 formed through a lower portion of the chassis, and the pin 24b fits into a

pin hole 29b formed through an opposite end of the support member 29 relative to the pin hole 29a as described in pages 6-7 of the Minato translation. Accordingly, the left and right brackets 23 and 24 can rotate and move in the vertical direction. Minato further discloses a tie rod 34 for connecting the left and right brackets 23 and 24 (see page 7 of the Minato translation). The tie rod 34 moves with brackets 23 and 24 during turning of the automobile, thereby forming a turning pair with the brackets (see page 9 of the Minato translation). Additionally, Minato discloses a leaf spring 36 comprising a curved shaft 37 supported in leaf spring 36, which extends longitudinally along an upper surface of the support member 29 and is supported at an intermediate portion of the support member 29 (see page 7 of the Minato translation). The ends of the leaf spring 36 abut against the distal ends of the upper pivot pins 23b, 24b of the left and right brackets 23, 24, respectively to prevent upward movement of the brackets.

Additionally, figure 2 of Minato clearly shows top ends of the upper portions of the right and left shafts (23b, 24b) projecting vertically from the upper surface of the upper chassis (29) through the hole portions (29a and 29b) thereof and are in contact with a lower surface of the leaf spring 36 to be subjected to a downward biasing force caused by elastically deforming the leaf spring (figure 2 and page 11 which states that member 36 can be elastically deformed).

Duchemin shows the commonplace use of a curved middle portion 1a in a leaf spring 1 in a suspension system for a vehicle, see Fig 1 and column 2, lines 13-25. It would have been obvious to one of ordinary skill in the art to have used a curved middle portion for the leaf spring of Minato in view of the teaching of Duchemin so as to prolong

Art Unit: 3993

the life of the spring and prevent plastic deformation of the ends as is taught by Duchemin in column 1, lines 40-56. Duchemin further shows a center support 3 that clamps the curved middle portion of the leaf spring 1a and thus the ends "can" move individually.

Minato further shows a tie rod 34. The leaf spring is supported in an upper portion of the upper chassis to the broad degree recited. The loop-like members 38a, 38b are a portion of the upper chassis. The claimed invention differs from Minato only in that ends of the leaf spring can move individually. Duchemin further shows a center support 3 that clamps the curved middle portion of the leaf spring 1a and thus the ends "can" move individually. It would have been obvious to one of ordinary skill in the art to have utilized a fixed center support in Minato in view of the teaching of Duchemin so as to allow for increased flexibility of the ends of the spring while preventing plastic deformation as taught by Duchemin.

Regarding claim 21, Minato shows a running toy.

Rejections Proposed by the Third Party Requester in Comments Filed

April 27, 2007

37. **Ground #35.** The Third Party Requester proposes that claims 5, 17 and 42 are obvious in view of Minato and Duchemin.

This proposed rejection is NOT adopted. Contrary to the requester's contention, Duchemin does not show a recess in the chassis. Duchemin merely shows a recess in

Art Unit: 3993

the clip 3, not the chassis. The views expressed in the Declaration by Mr. Rotheiser, filed 4/27/2007, relate only to conclusions and are not deemed persuasive because they do not address the fact the Duchemin fails to show a recess in the chassis.

38. **Ground #36.** The Third Party Requester proposes that claims 6, 18 and 43 are obvious in view of Minato and Duchemin.

This proposed rejection is NOT adopted. Claims 6, 18 and 43 depend from claims 5, 17 and 42. As claims 5, 17 and 42 are not rejected by Minato and Duchemin, their dependent claims are likewise not rejected.

39. **Ground #37.** The Third Party Requester proposes that claim 44 is obvious in view of Minato and Duchemin.

This proposed rejection is NOT adopted. Contrary to the requester's contention, Duchemin does not show a recess in the chassis. Duchemin merely shows a recess in the clip 3, not the chassis.

40. **Ground #38.** The Third Party Requester proposes that claim 45 is obvious in view of Minato and Duchemin.

The rejection is no longer adopted in view of the amendment on 10/24/2007.

Neither Minato nor Duchemin show a leaf spring which is located at an upper surface of an upper chassis, and which has a middle portion that is supported in the **upper surface** by a first shaft received by the upper chassis.

41. **Ground #39.** The Third Party Requester proposes that claim 46 is obvious in view of Minato and Duchemin.

This proposed rejection is no longer adopted in lieu of the above discussion relating to claim 45 in that claim 46 depends on claim 45.

42. **Ground #40.** The Third Party Requester proposes that claims 5, 17 and 42 are obvious in view of Minato and Balthazor (US Patent 3,083,499).

This proposed rejection is NOT adopted. Contrary to the requester's contention, Balthazor does not show a recess in the upper surface of that chassis. Balthazor shows a recess in the lower portion of the chassis. In addition, there is no teaching of reversing the arrangement of Balthazor in order to arrive at leaf spring mount as recited in claims 5, 17 and 42.

43. **Ground #41.** The Third Party Requester proposes that claims 6, 18 and 43 are obvious in view of Minato and Balthazor.

This proposed rejection is NOT adopted. Claims 6, 18 and 43 depend from claims 5, 17 and 42. As claims 5, 17 and 42 are not rejected by Minato and Balthazor, their dependent claims are likewise not rejected.

44. **Ground #42.** The Third Party Requester proposes that claim 44 is obvious in view of Minato and Balthazor.

This proposed rejection is NOT adopted. Contrary to the requester's contention, Balthazor does not show a recess in the upper surface of that chassis. Balthazor shows a recess in the lower portion of the chassis. In addition, there is no teaching of reversing the arrangement of Balthazor in order to arrive at leaf spring mount as recited in claims 5, 17 and 42.

Art Unit: 3993

45. **Ground #43.** The Third Party Requester proposes that claim 45 is obvious in view of Minato and Balthazor.

The rejection is no longer adopted in view of the amendment on 10/24/2007. Neither Minato nor Balthazor show a leaf spring which is located at an upper surface of an upper chassis, and which has a middle portion that is supported in the **upper surface** by a first shaft received by the upper chassis.

46. **Ground #44.** The Third Party Requester proposes that claim 46 is obvious in view of Minato and Balthazor.

This proposed rejection is no longer adopted in lieu of the above discussion relating to claim 45 in that claim 46 depends on claim 45.

47. **Ground #45.** The Third Party Requester proposes that claims 42-46 fail to claim a critical feature.

This proposal is not adopted. There is no requirement that every feature and/or structure of an invention be claimed. Please note the previous discussion of In re Mayhew, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976) in paragraph 15 above.

48. **STATEMENT OF REASONS FOR PATENTABILITY AND/OR CONFIRMATION**

The following is an examiner's statement of reasons for patentability and/or confirmation of the claims found patentable in this reexamination proceeding: claims 1-4, 7-12, 22-25 and 28-41 have been canceled. Claims 5 and 6 are confirmed. Claims 13-19, 26, 27 and 42-50 are patentable. Claims 5, 26, 42 and 44 are each considered patentable because the prior art fails to show or suggest a recess portion formed in the upper surface of the upper chassis at a middle portion where the curved middle portion of the

Art Unit: 3993

leaf spring is held in the upper chassis. Claims 6, 27 and 43 are considered patentable due to their dependency on claims 5, 26 and 42 respectively. Claims 13 is considered patentable because the prior art fails to show or suggest the middle portion of the leaf spring in a width direction being supported on an **upper surface** of the upper chassis as now recited in claim 13. Claims 14-19 are considered to be patentable due to their dependency on claim 13. Claim 45 is considered patentable because the prior art fails to show or suggest a leaf spring which is located at an upper surface of an upper chassis, and which has a middle portion that is supported in the **upper surface** by a first shaft received by the upper chassis. Claim 46 is considered to be patentable due to their dependency on claim 45. Claims 47-50 are considered to be patentable due to their dependency on claims 5, 26, 42 and 44.

Any comments considered necessary by the PATENT OWNER regarding the above statement must be submitted promptly to avoid processing delays. Such submission by the patent owner should be labeled: "Comments on Statement of Reasons for Patentability and/or Confirmation" and will be placed in the reexamination file.

49. Response to Patent Owner's Remarks filed on 10/24/2007 and Third Party Requester's Comment's filed on 11/19/2007.

The Examiner concurs with the Patent Owner's comments relating to claims 13, 14, 15, 16 and 19 and 45 and 46 on pages 4-5 of the response in that Minato, Duchemin and Balthazor fail to show the connection of the leaf spring at the upper surface of the upper chassis. As to claims 20-21, the Examiner does not find the

Art Unit: 3993

Patent Owner's Comments to be persuasive. Claim 21 recites and upper portion and not an upper surface as argued. As to the comments regarding claims 20-21 in the Patent Owner's response of 3/30/2007, the center clip of Duchemin does allow individual movement in the proposed combination of Duchemin and Minato. The frame of the vehicle does not move in a perfectly vertical plane. Vehicle frames tilt under loads. Thus, under a tilting load, the leaf spring ends of Duchemin would be unevenly loaded and the leaf spring would compensate due to the ability of the individual ends to move independently. In response to Patent Owner's argument that Duchemin is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, Duchemin is a leaf spring in a vehicle, the same art as that of the claimed invention.

As to the Third Party Requester's comments of 11/19/2007, it is noted that the Third Party Requester has failed to supply any new arguments in relation to claims 5, 6, 17, 18, 26, 27, 42, 43 and 44. The Third Party Requester has also failed to supply any new arguments relating to amended claims 13, 20, 45 and 46. Nor has the Third Party Requester supplied any new arguments relating to newly added claims 47-50.

50. **This is a RIGHT OF APPEAL NOTICE (RAN);** see MPEP § 2673.02 and § 2674. The decision in this Office action as to the patentability or unpatentability of any

original patent claim, any proposed amended claim and any new claim in this proceeding is a FINAL DECISION.

No amendment can be made in response to the Right of Appeal Notice in an *inter partes* reexamination. 37 CFR 1.953(c). Further, no affidavit or other evidence can be submitted in an *inter partes* reexamination proceeding after the right of appeal notice, except as provided in 37 CFR 1.981 or as permitted by 37 CFR 41.77(b)(1). 37 CFR 1.116(f).

Each party has a **thirty-day or one-month time period, whichever is longer**, to file a notice of appeal. The patent owner may appeal to the Board of Patent Appeals and Interferences with respect to any decision adverse to the patentability of any original or proposed amended or new claim of the patent by filing a notice of appeal and paying the fee set forth in 37 CFR 41.20(b)(1). The third party requester may appeal to the Board of Patent Appeals and Interferences with respect to any decision favorable to the patentability of any original or proposed amended or new claim of the patent by filing a notice of appeal and paying the fee set forth in 37 CFR 41.20(b)(1).

In addition, a patent owner who has not filed a notice of appeal may file a notice of cross appeal within **fourteen days of service** of a third party requester's timely filed notice of appeal and pay the fee set forth in 37 CFR 41.20(b)(1). A third party requester who has not filed a notice of appeal may file a **notice of cross appeal within fourteen**

Art Unit: 3993

days of service of a patent owner's timely filed notice of appeal and pay the fee set forth in 37 CFR 41.20(b)(1).

Any appeal in this proceeding must identify the claim(s) appealed, and must be signed by the patent owner (for a patent owner appeal) or the third party requester (for a third party requester appeal), or their duly authorized attorney or agent.

Any party that does not file a timely notice of appeal or a timely notice of cross appeal will lose the right to appeal from any decision adverse to that party, but will not lose the right to file a respondent brief and fee where it is appropriate for that party to do so. If no party files a timely appeal, the reexamination prosecution will be terminated, and the Director will proceed to issue and publish a certificate under 37 CFR 1.997 in accordance with this Office action.

51. Please mail any communications to:

Attn: Mail Stop "Inter Partes Reexam"
Central Reexamination Unit
Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

Please FAX any communications to:

(571) 273-9900
Central Reexamination Unit

Please hand-deliver any communications to:

Customer Service Window
Attn: Central Reexamination Unit
Randolph Building, Lobby Level
401 Dulany Street
Alexandria, VA 22314

Application/Control Number: 95/000,036

Page 35

Art Unit: 3993

Any inquiry concerning this communication or earlier communications from the Examiner, or as to the status of this proceeding, should be directed to the Central Reexamination Unit at telephone number (571) 272-7705.

Signed:



Matthew C. Graham

CRU Examiner

3993

(571) 272-7116

Conferees: 

